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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/538,805      | 03/30/2000  | Jay S. Walker        | 99-077              | 7826             |

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EXAMINER

CUFF, MICHAEL A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/538,805

Applicant(s)

Walker et al.

Examiner

Michael Cuff

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 30, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

Art Unit: 3627

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. Items Q and DD from the IDS were not included in the group of references supplied to the examiner. Applicant is requested to supply copies of these references.

### ***Specification***

2. The specification is objected to for not having antecedent basis for the following claimed terms, “means for receiving”, “means for identifying” and “means for determining”.

### ***Claim Objections***

3. The claims are objected to in that there are two claim 56s. For the purposes of examination they will be referred to as the 1st and 2nd claim 56 as they appear in the original application.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3627

5. Claim 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 63 recites the following terms, “means for receiving”, “means for identifying” and “means for determining”. Because these terms have not been defined by the specification, it is unclear as to the scope of what they define.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-59 show a series of steps which are grounded in the abstract idea of, for example, receiving, identifying and determining. The broadly recited steps do not recite sufficient computer structure that are within “technological arts”. Therefore, they do not satisfy the statutory requirements of 35 USC 101. See *In re Toma*, 197 USPQ 852 (CCPA 1978).

The changes to fix this issue are relatively minor. For example, Claim 1 could be re-written so that the third step read --determining terms of a subscription by the controller for the product ... --.

Art Unit: 3627

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(f) he did not himself invent the subject matter sought to be patented.

9. Claims 60-62 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Isobe et al..

Isobe et al. shows, figure 3, show a computer system on a network with storage and communication capability.

Note that because applicant has chosen to use “adapted to” language, very little patentable weight has been given to the limitations following the adapted to” phrase. See MPEP 2106, section II, part C which gives guidance on this type of language.

Art Unit: 3627

10. Claims 1-43, 45-50 and 52-63 are rejected under 35 U.S.C. 102(e) and (f) as being anticipated by Walker et al. as disclosed below in the double patenting rejection.. See double patenting chart.

### ***Double Patenting***

At this stage, the examiner is not aware of a common assignee between the application and the patents which will be used in the following double patenting rejections. There is at least one common inventor. The examiner is using chart II-B of MPEP 804 as guidance for the following rejections.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Art Unit: 3627

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-6, 11-17, 22-34, 41-43, 45-48, 49-50, 52-54 and 2nd 56-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29 and 52 of U.S. Patent No. 5,926,796. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed method is drawn to a generic broad product and the patent is drawn to a specific product which still shows the generic method. The patented claims also recite the unique term "retail subscription system" which is a term where the patented applicant was his own lexicographer and therefore there are many processes inherent by merely claiming the use of this system.

13. Claims 1-3, 5, 11-17, 22-40, 53, 54, 55 and 1st 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 43, 18-22 and 48 of U.S. Patent No. 6,415,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed method is drawn to a generic broad product and the patent is drawn to a specific product which still shows the generic method.

Art Unit: 3627

14. Claims 1-3, 5, 11-17, 22-34, 53, and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,196,458. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed method is drawn to a generic broad product and the patent is drawn to a specific product which still shows the generic method.

15. Claims 1-3, 5, 8-17, 22-34, 53, and 54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 6 of U.S. Patent No. 6,317,723. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed method is drawn to a generic broad product and the patent is drawn to a specific product which still shows the generic method.

16. Claims 44 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29 and 52 of U.S. Patent No. 5,926,796 in view of Walker et al. (6,415,262) claim 21 .

Walker et al. (5,926,796), as applied in claim 1, shows all of the limitations of the claims except for specifying the use of penalties with subscriptions.

Walker et al.('262) teaches, claim 21, the use of penalties with subscriptions in order to ensure subscription fulfillment.



Art Unit: 3627

Based on the teaching of Walker et al. ('262), it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Walker et al. system to use penalties with subscriptions in order to ensure subscription fulfillment.

### *Conclusion*

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bolam et al., Eggleston et al., Finley et al., and Walker et al. (6,470,322; 6,249,772, and 5,970,470) show systems of interest.

18. Any inquiry concerning this communication should be directed to Michael Cuff at telephone number (703) 308-0610.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113. The fax phone number for this Group is (703) 872-9326. (After Final special fax number (703) 872-9327) The customer service number is (703) 872-9325.

 12/11/02  
Michael Cuff  
December 11, 2002